

REMARKS

It appears that the Examiner has not yet provided a corrected PTO-892 form as requested in Applicants' previously filed amendment. Accordingly, it is again noted that the PTO-892 form issued by the Examiner appears to have a mistake in the listed foreign prior art. In particular, the PTO-892 mistakenly indicates that the document number for the published Japanese application to Miyama et al. is JP 03-080548. However, it is respectfully submitted that the correct number is JP 03-089548. It is respectfully requested that the Examiner issue another PTO-892 form having the proper document number for Miyama et al. so as to correct the record.

Furthermore, as the outstanding Office Action was again sent to the wrong address, Applicants enclose herein a copy of the Revocation of Power of Attorney and Request for a Change of Address to ensure future correspondence from the PTO is sent to the correct address. IT IS RESPECTFULLY REQUESTED THAT THE PTO RECORDS BE CORRECTED TO IDENTIFY THE PROPER ADDRESS TO SEND CORRESPONDENCE TO APPLICANTS.

That is, please address all future correspondence to:

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Claims 1 and 13 are the sole independent claims and stand rejected under 35 U.S.C. § 103 as being unpatentable over Mulatti et al. '914 ("Mulatti") in view of Burr '142 ("Burr"). This rejection is respectfully traversed for the following reasons. In general, it is submitted that the proposed combination is improper, and even assuming *arguendo* proper, the proposed combination does not disclose each and every limitation of the claimed invention.

A. Proposed combination improper

The Examiner admits that Mulatti does not disclose a source electrode connected to the source and separated from an electrode of the respective well. The Examiner alleges that Burr discloses the aforementioned feature and thereby attempts "to modify the switching element of Mulatti by providing a separate source electrode as taught by Burr to provide a separate each component with a desired potential." As a preliminary matter, contrary to the Examiner's reliance thereon, Mulatti does not disclose a "switching element" but rather is directed to an "inverter circuit" as characterized by the connection between the well and the source, the drain supplied with Vcc voltage, the source supplied with Gnd and the input signal supplied to the gate.

Nonetheless, it is respectfully submitted that the Examiner's motivation for making the combination is *per se* improper. The Examiner merely alleges that the combination would have been obvious "to provide a separate each component with a desired potential." That is, the Examiner's proposed combination modifies Mulatti by providing a separate source electrode for the purpose of providing a separate source electrode. This motivation amounts to merely making a conclusory statement that it would have been obvious to make the combination for the purpose of making the combination. It is submitted that such a motivation is not sufficient under the law governing § 103.

Only Applicants have recognized and considered providing a source electrode that is separated from an electrode of the respective well *in combination* with a high frequency signal separation means. Mulatti expressly discloses a source electrode that is NOT separated from the respective well electrode and indeed appears to suggest the desire of such a connection for carrying out the disclosed purpose. Burr, on the other hand, *is unrelated to the unique configuration of a transistor/inductor connection*. Burr discloses separated source and well electrodes incidentally as simply a conventional element for traditional transistor configurations. Burr appears silent as to providing motivation for using such a conventional element, *let alone provide motivation for using a separated source and well electrode specifically in combination with the transistor/inductor configuration of Mulatti*. In short, Mulatti appears to desire the connected source/well electrode so as to teach away from the proposed combination, and Burr is directed to a completely different transistor configuration using a conventional separated source/well electrode which is unrelated to the Mulatti transistor/inductor configuration.

The Examiner is directed to MPEP § 2143.03 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that Mulatti can be modified by Burr, it is submitted that the "mere fact that [Mulatti and Burr] can be combined ... does not render the resultant combination obvious" because nowhere does the *prior art* "suggest the desirability of the combination" as set forth by the Examiner. It is submitted that the Examiner's asserted motivation at best attempts to evidence that the proposed combination *can* be made. Neither

Mulatti nor Burr *suggest the desirability* of the combination for any technical purpose. That is, neither Mulatti nor Burr suggest any benefits/advantages of providing a separated source and well electrode in the *specific* transistor/inductor device of Mulatti.

The Examiner is also directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that Mulatti and Burr "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no *objective* reason on the record to combine the teachings of the cited prior art. As mentioned above, the Examiner does not provide any evidence *from the prior art* as to why the proposed combination would provide any benefits or advantages to the particular transistor/inductor device of Mulatti, nor does the Examiner identify any disclosed technical purpose for the proposed combination.

At best, the Examiner has attempted to show only that the elements of the claimed invention are *individually* known without providing a *prima facie* showing of obviousness that the *combination* of elements recited in the claims is known or suggested in the art. In this regard, it is submitted that the Examiner has relied solely on improper hindsight reasoning, whereby the Examiner selected bits and pieces of the prior art and used only Applicants'

specification as a guide to reconstruct the claimed invention. For all the foregoing reasons, it is respectfully submitted that the proposed combination of Mulatti and Burr is improper.

B. Proposed combination does not disclose each and every limitation

Moreover, it is submitted that the proposed combination does not disclose the claimed invention. Independent claims 1 and 13 each embody an input signal node connected to the source. In contrast, Mulatti discloses only an inverter circuit, as opposed to a switch circuit, which inverter circuit is characterized in that the input signal is supplied to the gate; and Burr discloses only a separated power source supplied to the source and the well.

As described throughout Applicants' specification, the present invention can, to list just a couple of examples, provide the capability of using an inductor to block a high frequency component of a signal passing between an n-type well of a p-channel FET and a voltage supply node, and, using a FET to block the flow of a high frequency signal between a p-type substrate region and a n-type well. Indeed, even when the high frequency switch circuit is integrated together with other semiconductor circuits into a p-type silicon substrate, the signal leak via the back gate can be reduced, thereby reducing the transmission loss of a high frequency signal. As mentioned above, Mulatti discloses only an inverter circuit, as opposed to a switch circuit, which inverter circuit is characterized by the connection between the well and the source, the drain supplied with Vcc voltage, the source supplied with Gnd *and the input signal supplied to the gate*. Whereas, according to one aspect of the present invention, the switch circuit can be characterized with a well region, separated from the source region, that can be supplied with bias voltage, a source and drain region which can be supplied with unlimited voltage, and a source that can be supplied with the input signal.

The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1 and 13 because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 13 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is submitted that claims 1-27 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 103 be withdrawn.

CONCLUSION

Having fully and completely responded to the Office Action, Applicants submit that all of the claims are now in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's

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amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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